

REMARKS

Applicants submit this Amendment in response to the final Office Action mailed September 15, 2006. Applicants respectfully traverse all pending objections and rejections and request reconsideration of the application, as amended.

Claims 21-41 are currently pending, of which claims 21, 30, 39, 40, and 41 are independent. In the final Office Action mailed September 15, 2006, the Examiner rejected claims 21-23, 25-37, and 39-41 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent Abstract JP 57-200238 to Nakahara et al. ("Nakahara"). The Examiner objected to claims 24 and 38 as being dependent upon rejected base claims, but indicated that these claims would be allowable if rewritten in independent form.

Applicants have amended claims 21, 30, 33, 37, 39, and 40 to better define the claimed invention. The pending claim amendments were previously discussed with the Examiner in a telephone conversation on November 15, 2006. In that conversation, the Examiner agreed that the claim amendments presented in this response would overcome the pending 35 U.S.C. § 102(b) rejections over Nakahara.

35 U.S.C. § 102(b) Rejections over Nakahara

Applicants respectfully traverse the rejections of claims 21-23, 25-37, and 39-41 under 35 U.S.C. § 102(b) as being anticipated by Nakahara. In order to properly establish an anticipation rejection under 35 U.S.C. § 102(b), each and every element of the claims at issue must be found in the applied prior-art reference, either expressly or under principles of inherency. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed.

Cir. 1989). In this case, Nakahara fails to disclose each and every element of the Applicants' claimed invention, as discussed in more detail below.

Applicants respectfully submit that Nakahara fails to teach or suggest at least "the geometrical parameter being different than the at least one measuring point," as recited in Applicants' representative claim 21, as presently amended. For at least this reason, Nakahara cannot anticipate claim 21 under 35 U.S.C. § 102(b). Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 21 as being anticipated by Nakahara.

Nakahara teaches a technique for drawing a glass rod having a uniform outer diameter. See Nakahara, Purpose. According to Nakahara, a "point to complete the deformation" is determined from the relationship between the zone in which the diameter of the rod varies and the zone having uniform diameter. See *id.*, Constitution. To control the outer diameter of the rod as it is being drawn, the pulling rate of the rod is adjusted based on the rod's diameter at its point to complete the deformation. See *id.*

At page 3 in the non-final Office Action dated March 10, 2006, the Examiner observed that the "point to complete deformation" in Nakahara is a measuring point where a glass-rod diameter is determined for controlling an elongation process.¹ ("the diameter at this point [of complete deformation] is used to control the elongation"). Thus, the Examiner apparently equated Nakahara's point to complete the deformation

¹ The Office Actions contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Actions.

with the Applicants' claimed "at least one measuring point."² In the final Office Action dated September 15, 2006, the Examiner expressly equated the point to complete the deformation in Nakahara with Applicants' claimed "geometrical parameter."³ See final Office Action, p. 3 ("[t]he position of the point to complete deformation is equated to the geometrical parameter"). In sum, the Examiner apparently has equated the point to complete the deformation in Nakahara with both the Applicants' claimed "geometric parameter" and "at least one measuring point."

Claim 21, as presently amended, recites "the geometrical parameter being different than the at least one measuring point" (emphasis added). Thus, while Nakahara discloses a geometrical parameter and measuring point corresponding to the same "point to complete the deformation," Applicants' amended claim 21 instead requires "the geometrical parameter being different than the at least one measuring point." Consequently, the point to complete the deformation taught in Nakahara cannot anticipate both the Applicants' claimed "geometric parameter" and "at least one measuring point," since claim 21 explicitly recites "the geometrical parameter being different than the at least one measuring point."

² Claim 21 calls for a combination including, for example, "determining, during the step of elongating, the preform diameter in at least one measuring point along the preform" and "controlling the step of elongating on the basis of the determined diameter." (emphasis added)

³ Claim 21 calls for a combination, including, for example, "measuring, during the step of elongating, at least a geometrical parameter of the preform" and "controlling, during the step of elongating, the position of said at least one measuring point according to the measured geometrical parameter." (emphasis added)

In view of the foregoing, the pending 35 U.S.C. § 102(b) rejection of Applicants' amended claim 21 is improper and should be withdrawn. Independent claims 30, 39, 40, and 41, although different in scope from independent claim 21, recite similar claim language and are thus allowable for at least the same reasons. Claims 22-29 and 31-38 depend on allowable independent claims 12 and 30 and are therefore also allowable for at least the same reasons.

Conclusion

The preceding arguments are based only on arguments presented in the pending Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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